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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,174	10/30/2003	Howard Shelton Lambert	GB920020091US1	2506
7590	10/10/2006		EXAMINER KOEMPEL THOMAS, BEATRICE L	
IBM Corporation IP Law Department 11400 Burnet Road Austin, TX 78758			ART UNIT 2196	PAPER NUMBER

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,174

Applicant(s)

LAMBERT ET AL.

Examiner

Bea Koempel-Thomas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20060830.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1-12 are pending in this application and presented for examination.

Specification

2. The disclosure is objected to because of the following informalities: "an environment" (page 8, line 19) is disclosed without disclosing the corresponding reference number, and is not included in Figure 2. Additionally, (page 8, line 19 and page 11, line 8) discloses "a user" without disclosing the corresponding reference number as illustrated in Figure 2. Appropriate correction is required.
3. The disclosure is objected to because applicant describes using present **or future** memory and communications technologies (page 14, lines 14-19). However, the applicant does not provide any details of how the person of ordinary skill in the art would actually **use future** memory or communications technologies when they do not yet exist. The compatibility of any future technologies with applicant's invention is unknown. Thus, the applicant does not have possession of such future technologies.

Abstract

4. The abstract of the disclosure is objected to because it is substantially a copy of claim 1, and includes the legal phraseology "**means**" in lines 9, 11, and 15. In its current form, it fails to provide a clear disclosure of that which is new in the art to which the invention pertains. Correction is required. See MPEP § 608.01(b).
5. Applicant is reminded of the proper language and format for an abstract of the disclosure. The form and legal phraseology often used in patent claims, such as "**means**"

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and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be a clear and concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because Figure 1 includes the following reference characters not mentioned in the description:

115 and 120. The drawings are also objected to under 37 CFR 1.83(a) because Figure 1 fails to show "multiple users" as described in the specification.

7. In Figure 1, reference characters 105 and 110 appear to refer to the "multiple users" described in the specification, and 120 appears to refer to the "shared device" described in the specification as referenced by character 110. However, reference character 115 is not identified in any way and its structure and purpose are unclear.

8. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as

either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

9. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the corrected drawing and marked-up copy will result in the abandonment of the application.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In claim 12, a "computer program" is recited. The computer program of claim 12 is not claimed as embodied in computer readable media, and is reasonably interpreted by one of ordinary skill in the art as software, per se. Claim 12 sets forth a mere program listing failing to define any structural and functional interrelationships between the computer program and other claimed elements of a computer which would permit the

computer program's functionality to be realized. As such, it is believed that the computer program of claim 12 is reasonably interpreted as functional descriptive material, per se.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, and 3-12 are rejected under 35 U.S.C. 102 (b) as being anticipated by Howard Shelton Lambert, et al., US Patent No. 6,282,649 B1, (hereinafter "Lambert").

14. As to **claim 1**, Lambert discloses a data processing system for controlling access of at least one user to stored data (column 2, lines 2-3, "a data processing system . . . for controlling user access to data," column 4, line 6, "retail till or automatic teller terminal," *see also* Figure 1) comprising: means, responsive to a request from the user to access a set of the stored data, for authenticating the user (column 2, lines 11-12, 33-35 "If the user key represents the required level of access authority an access key is generated from the user key for accessing that data or service. . . . a user presents a token and inputs personal data (for example a personal identification number or PIN, input via a keypad)," Figure 1, and column 4, lines 22-25 "Partial key data (5) is read from a card presented by a user and supplied to a key generator (7). Personalised data such as a personal identification number (PIN) or biometric data is obtained from the user by a reader (8)"); means, responsive to successful authentication, for decrypting an encrypted data structure

associated with the user (column 4, line 16 “A decryption service module”), wherein the data structure comprises data associated with the set (column 2, lines 1-28 (encrypted data structure contains data (applets) associated with the user via authority levels, and the data structure comprises data associated with the set (the applets). Also, column 4, lines 7-10 “An application store is provided to retain in encrypted form those applications which the terminal may be called on to perform, according to the authority of users requesting the application.”); and means, responsive to successful decryption, for accessing the set (column 2, lines 38-39 “controlling user access to data or services via a computer system,” column 4, lines 5-6 “retail till or automatic teller terminal,” *see also* Figure 1, and column 5, line 29 “a checkout terminal,” *see also* Figure 4).

15. As to **claim 3**, Lambert further discloses an encrypted set (column 2, line 27-28 “data . . . stored in an encrypted form,” column 4, line 7-9 “An application store . . . retain[s] in encrypted form those applications which the terminal may be called on to perform”), and the data associated with the set comprising data associated with decryption of the set (column 2, line 26-28 “decryption keys for accessing data . . . stored in an encrypted form,” column 4, lines 9-10, 16-19 “according to the authority of users requesting the application . . . [a] decryption service module . . . to decrypt a selected applet under the control of a decryption key”).

16. As to **claim 4**, Lambert further discloses a set comprising all of the stored data (column 4, lines 7-10 “[a]n application store is provided to retain in encrypted form those applications which the terminal may be called on to perform, according to the authority of users requesting the application”).

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17. As to **claim 5**, Lambert further discloses a set comprising portion of the stored data (column 3, line 28 “different sets,” column 4, line 19 “a selected applet”).

18. As to **claim 6**, Lambert further discloses a user request initiated by presentation of a token by the user (column 2, lines 33-34 “a user presents a token,” column 4, lines 29-30 “The preferred system provides for access to be controlled using a smart card”).

19. As to **claim 7**, Lambert further discloses a token comprising means associated with the identity of the user (column 1, lines 56-58 “identification of the user from . . . data held on a token such as a SmartCard,” column 4, lines 41-42 “Partial data is read from the operator’s card”).

20. As to **claim 8**, Lambert further discloses a means associated with the identity of the user derived from one or more biometric characteristics associated with the user (column 3, lines 7-8 “biometric data,” column 4, line 42 “biometric data”).

21. As to **claim 9**, Lambert further discloses a token comprising the means for decrypting (column 3, lines 37-40 “Advantage is taken of the processing and storage facilities available on the [smart] card to perform . . . the decryption[,]” column 4, lines 34-37 “If sufficient processing and storage facilities are available on the card, the security of the system may be further enhanced by performing the decryption process itself using these facilities”).

22. As to **claim 10**, Lambert further discloses stored data capable of access by more than one user (column 5, line 14 “multiple log ons are permitted”), and means for accessing data associated with each user of the more than one users (column 5, line 14-18 “permits only multiple log ons which conform to certain rules. For example the rule may

require that only one valid operator is permitted with one valid supervisor, there being no other valid case of multiple log on”).

23. As to **claim 11**, Lambert further discloses a method for controlling access of at least one user to stored data via a data processing system (column 2, lines 2-3, “a data processing system . . . for controlling user access to data,” column 4, line 6, “retail till or automatic teller terminal,” *see also* Figure 1), comprising the steps of: in response to a request from the user to access a set of the stored data, authenticating the user (column 2, lines 11-12, 33-35 “If the user key represents the required level of access authority an access key is generated from the user key for accessing that data or service. . . . a user presents a token and inputs personal data (for example a personal identification number or PIN, input via a keypad),” Figure 1, and column 4, lines 22-25 “Partial key data (5) is read from a card presented by a user and supplied to a key generator (7). Personalised data such as a personal identification number (PIN) or biometric data is obtained from the user by a reader (8)”); in response to successful authentication, decrypting an encrypted data structure associated with the user (column 4, line 16 “A decryption service module”), wherein the data structure comprises data associated with the set (column 2, lines 1-28 (encrypted data structure contains data (applets) associated with the user via authority levels, and the data structure comprises data associated with the set (the applets). Also, column 4, lines 7-10 “An application store is provided to retain in encrypted form those applications which the terminal may be called on to perform, according to the authority of users requesting the application.”); and in response to successful decryption, accessing the set (column 2, lines 38-39 “controlling user access to data or services via a computer system,” column 4, lines 5-6 “retail till or automatic teller

terminal,” *see also* Figure 1, and column 5, line 29 “a checkout terminal,” *see also* Figure 4).

24. As to **claim 12**, Lambert further discloses a computer program comprising program code means adapted to perform the steps of claim 11, when said program is run on a computer (columns 2-3, lines 66-67, 1-3 “a computer program product comprising computer readable program code stored on a computer readable storage medium, the computer program code providing the functions for controlling access to stored data,” column 4, line 38 “the till program invokes an applet controlling operator LOG ON”).

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lambert as applied to claim 1 above, and further in view of Bartocci et al., European Patent Application Publication No. 0 204 994 A2, (hereinafter “Bartocci”).

27. As to **claim 2**, Lambert fails to teach data associated with the set comprising data associated with the location of the set.

Bartocci teaches data associated with the set comprising data associated with the location of the set (column 7, lines 1-4 “User Data Pointer [--] This is location dependent address information used to direct access at this DSU [Directory Service Unit] to user data” *see also* Figure 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lambert by the user data pointer for data associated with the set to include the location of the set as taught by Bartocci in order to enable remote data management.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is:

- Benaloh, U.S. Patent No. 7,047, 422 B2, referring to a unique data subset of a database.
- Dillaway et al, U.S. Patent No. 5,742,756, referring to a system and method of using smart cards to perform security-critical operations requiring user authorization.
- Moran, U.S. Patent No. 6,539,380, referring to a device, system and method for data access control using biometric characteristics.
- Weiss, U.S. Patent No. 5,657,388, referring to a method and apparatus for utilizing a token for resource access.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bea Koempel-Thomas whose telephone number is 571-270-1252. The examiner can normally be reached on Monday - Thursday & alternate Fridays; 0730 - 1700.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on 571-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bkt



Andrew Y. Koenig

PRIMARY EXAMINER

AU 2623